IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Erik Rucker et al.	Examiner:	Desai, Rachna Singh
Serial No.:	09/598,856	Group Art Unit:	2176
Filed:	June 21, 2000	Confirmation No.:	6692
		Docket No.:	MS149424.01/40062.0177US01
Title:	System and Method for Enabling Simultaneous Multi-User Electronic Document Editing		

CERTIFICATE UNDER 37 CFR 1.8:
I hereby certify that this paper is being transmitted via EFS-Web to the U.S. Patent and Trademark Office on June 27, 2008.

By: _____
Name: Mary Notter

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit a reply brief under 37 C.F.R. § 41.41 in response to the Examiner's Answer dated April 28, 2008. The current appeal relates to the Final Rejection of claims 1-14 and 16-28.

It is believed that no fee is required for submission of this reply brief. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

I.   **The Examiner's Answer Fails to Fully Respond to Appellants' Arguments and Fails to Show How the Cited References Make Appellants' Claims Obvious.**

The Examiner's Answer does not substantially add to arguments presented by the Examiner during prosecution and fails to fully respond to arguments presented in Appellants' Appeal Brief filed on February 1, 2008. Appellants continue to disagree with the Examiner's Answer for all the reasons set forth in the Appeal Brief, but certain of Appellants' arguments are highlighted below because they still have not been substantially addressed by the Examiner.

   A. **Brown Does Not Disclose the Claimed Steps Taken in Response to Determining that the Original Document is Open at a Second User.**

With respect to Claim 1 and the Brown reference, Applicants concentrate their remarks in this Reply on two claim elements. Claim 1 requires, *inter alia*:

> "determining whether the original document is open at a second user, wherein the second user has exclusive rights to save the original document while the original document is open at the second user;
>
> in response to a determination that the original document is open at the second user, creating a local copy and storing a path of the original document with the local copy"

(Claim 1).

The Examiner's Answer (1) deconstructs these two elements individually, (2) treats the two elements as if they have nothing to do with one another, and (3) never exactly states what the Examiner considers to be the step of "determining whether the original document is open." For example, the Examiner's Answer states that: "Brown discloses a method for simultaneous multi-user editing of a document where the system recognizes multiple-user editing of the document which meets the limitation, determining whether the original document is open at a second user." (Examiner's Answer at pp. 24-25). Applicants disagree. In fact, as reiterated below, Brown teaches directly away from this by creating a multi-user editing system where the determination of whether the

document is open is entirely irrelevant. Nor do the Examiner's generalized allusions from the Background of the Invention shed any more light. That Brown "teaches a method and system for allowing another user to access the document when the document is already in use by another user . . ." (Examiner's Answer at p. 25) does not require that the claimed determination step occur. In fact, as discussed below, Brown teaches a method that does not change depending on whether a user is the first to access a document or the one-hundredth user to do so.

Moreover, the Examiner treats the remainder of the determining step– "wherein the second user has exclusive rights to save the original document while the original document is open at the second user" – as if it were entirely separate. It is not. The word "open" in the determining step is modified, in part, by the "wherein" clause. The Examiner, however, cites to a completely different part of Brown here – "Brown teaches a user saving a file has exclusive rights to save the original document so long as the MCF is in an 'unlocked mode,' where no other users are saving. Once the user initiates a "save" operation, then at that moment, the user has exclusive rights to save the original document because no other user will be able to save their document." (Examiner's Answer at p. 26).

Taking the Examiner's argument to its logical conclusion, the "determining" of whether a document is "open" at another user is equated by the Examiner to Brown's determining whether the MCF is locked or unlocked. Applicants respectfully submit that under no reasonable interpretation could the determination whether the MCF is locked or unlocked be considered to meet the limitation of "determining whether the original document is open at the second user." Moreover, as discussed below, accepting this position leads to a conclusion that Brown teaches exactly the opposite of what is claimed in the next claim element. In short, the Examiner never points out what she considers to be the claimed "determining" step in Brown; and the only proffered candidate in Brown to meet the claimed "determining" step leads to a significant disconnect in mapping the next claim element.

The next claim 1 element, "in response to a determination that the original document is open at the second user, creating a local copy and storing a path of the original document with the local copy," is also not met by Brown. Because the

"creating" step is "in response to" the "determining" step that the Examiner has never exactly mapped to Brown, it is difficult to respond to the Examiner's arguments. Here again, however, the Examiner cites to a different part of Brown. Specifically, the Examiner relies on Brown at Col. 10 & 11 under the heading "The Multi-User Program Module." (Examiner's Answer, pp. 26-27). The cited sections simply recognize that sometimes only one user at a time will be editing a document. The Examiner concludes from these sections, however, that: "Therefore, Brown certainly teaches opening local copies in response to determining multi-user editing of a document." (Examiner's Answer, pp. 26-27). A closer reading of Brown, however, reveals that an MCF and a local copy are created _regardless_ of whether another user already has the document open. _See_ Brown Figures 2A, 2B, and 2D (If the MCF does not exist (220), the MCF is created (221), and a local copy is created (250) and edited by the user (255)). There is _no difference_ in this procedure whether the user is the first, second, or tenth user to open the document. If only one user is editing the document, the MCF will be created but not have any effect – but the first user will still have only a local copy. In fact, Brown appears to be specifically designed so that no action is dependent a determination that the document is open at another user.

Moreover, as discussed above, it appears the Examiner may be asserting that claimed "determining" step is met by the determination in Brown of whether another user is currently saving edits from its local copy to the master copy (i.e., by checking whether the MCF is locked). Even if that were true, the Examiner has presented no argument that the local copy is created "_in response_ to a determination that the original document is open at the second user." In fact, even accepting the Examiner's faulty correlation of the original document being "open" to the MCF being "locked," Brown teaches directly away from this claimed limitation. In Brown, if the MCF is locked (_See_ Figure 2A, reference 235), the user waits until it is _unlocked_ before the master copy is accessed (230) and the local copy is created (250), which is akin (according to the Examiner's analogy) to waiting until the document _is no longer open_ at another user before creating a local copy. This is the _exact opposite_ of what claim 1 requires. The Examiner's Answer completely fails to address this contradiction.

B. The Combination of Miller with Brown Does Not Make Up for the Deficiencies of Brown, and Brown and Miller are not properly Combined.

The Examiner cites Miller for the step of "in response to a determination that the original document is still open at the second user, prompting the first user to decide between saving the local copy with the path of the original document such that a subsequent merge of the saved local copy and the original document can be performed, and saving the local copy as a separate file as compared to the original document" as recited in claim 1. However, Miller simply does not disclose this limitation.

Here again, the Examiner attempts to break the claim element into incongruous pieces in order to map it to Miller. For example, the Examiner asserts that the limitation "prompting the first user to decide" is met because "Miller teaches presenting options to a user." (Examiner's Answer at p. 29, citing Miller at paragraphs [0166]-[0173].) First, those paragraphs contain no suggestion that a user is "prompted." Rather, Miller paragraph [0166] simply states: "File options – The following functions may be provided, preferably for every file in the system . . . ." This does not state (or even imply) that the user is prompted to decide anything. Rather, the "options" could be made available without a specific user prompt.

Moreover, "prompting the user to decide" is not an isolated claim element. The full claim element requires "in response to a determination that the original document is still open at the second user, prompting the first user to decide between saving the local copy with the path of the original document such that a subsequent merge of the saved local copy and the original document can be performed, and saving the local copy as a separate file as compared to the original document." The Examiner, however, addresses the remaining portions of this element separately.

First the Examiner states that "in response to a determination that the original document is still open at a second user" is met by Miller teaching that a "person cannot replace a file if it is checked out by another user." (Examiner's Answer, at p. 29.) It is not clear in Miller, however, that any such determination is made. Rather, the critical factor in Miller is whether the user has the document checked out. (See Miller at paragraph [0169].) Even if there is a "determination that the original document is still

open at a second user" in Miller, however, the Examiner has shown no correlation between such a determination and prompting of the user in any way.

In addition, the Examiner appears to assert that paragraphs [0166]-[0173] illustrate "prompting the first user to decide between saving the local copy with the path of the original document such that a subsequent merge of the saved local copy and the original document can be performed, and saving the local copy as a separate file as compared to the original document." In particular, the Examiner cites that the "user has the option of modifying a file and either uploading it as a new file or different version of a current one, but the file can only be replaced if the user has checked it out." (Examiner's Answer at p. 29 (emphasis in original).) However, the only paragraph cited by the Examiner that is at all relevant is paragraph [0169], which states:

> "[0169] 3. View or download: a copy of the file is brought to the user's computer. This file can be modified there for the individual user's use. A modified version can be uploaded as a new file or different version of a current one, but a file in the repository can only be replaced if the user has it checked out."

The Examiner's argument simply does not track the claim element. First, as discussed, there is no disclosed prompting of the user in any way. Second, whether prompted or not, Miller does not disclose the two claimed choices. For example, in Miller, if the user has the document checked out, there is no reason to prompt the user for any choices about saving because that user will just save the document back to the repository. If the user does not have the document checked out, the user can "upload the file as a new file or different version of a current one."

Presumably, the Examiner asserts that the ability to save the file as a "different version of a current one" is the same as the claimed "saving the local copy with the path of the original document such that a subsequent merge of the saved local copy and the original document can be performed." Miller, however, provides no discussion whatsoever regarding how or whether changes saved in "a different version of a current [file]" are ever merged back into the original. Nor is there any discussion in Miller that a "different version of a current [file]" would be saved "with the path of the original

document such that a subsequent merge of the saved local copy and the original

document can be performed."

Miller is a basic check-in, check-out system – it allows one user at a time to edit a

document and it is simply unconcerned with merging edits from multiple users back into

a single document. Miller does not teach prompting the user to do anything in response

to a determination that the original document is still open.

Furthermore, contrary to the suggestion by the Examiner, there is no motivation to

combine Miller with Brown. In fact, Miller teaches away from Brown. Brown is

directed to a system wherein a plurality of users can all edit a document at the same time,

and a central-server process controls the versions and ensures saves of edits from various

local copies through the use of a MCF. The MCF is specifically designed not to have to

prompt a user whether to save locally. Miller, on the other hand, prohibits edits by

anyone except the user that has a document checked out. (*See* Miller, para. [0175]).

Miller also discloses that all other users must wait until after the document has been

checked back in to check the document out themselves and make any changes. Simply

put, Miller is designed specifically to prohibit multiple versions of a document being

propagated and later merged, whereas Brown encourages multiple versions of a

document to be created and merged by managing a sophisticated central server process.

For at least these reasons, Brown and Miller are not properly combined, and claim 1

should be allowed in its current form.

C. The Deficiencies in the Arguments Presented in the Examiner's Answer with Respect to Claim 1 are also Fatal to the Arguments Made Regarding Independent Claims 5, 13, and 21.

Claims 5, 13, and 21 include similar limitations relating to creating a local copy in

response to a determination whether the original document is "open" at another user. For

example and without limitation, claim 5 states in part: "in response to a determination

that the original document is open at a second user, creating and storing a local copy and

storing a path of the original document with the local copy." Moreover, the Examiner

continues to assert, <u>without explanation</u>, that Miller teaches "monitoring the original

document by periodically determining whether the original document is still open at the

second user." (See March OA, pp. 8-9.) That is simply untrue. Miller has no discussion whatsoever of monitoring whether a document is no longer open at another user, and the Examiner still has not cited any section of Miller that indicates otherwise. In fact, unlike the present claims, since Miller is not concerned with merging changes from a local copy back into the original document, there is no reason in Miller to "monitor" whether the original document is still open at another user (as opposed, for example, to simply checking whether the document has been checked out when a user attempts to access it).

Similarly, claim 13 states in part: "in response to a determination that the flag is set, the second local document editor is further operative to create a local copy of the original document"; and claim 21 states in part: "in response to a determination that the original document is open at the second user, creating a local document file and storing a path of the original document file as part of the local document file." For all of the reasons stated above, these claim limitations continue not to be met by Brown and Miller, alone, or in combination. The Examiner's argument with respect to other elements of claims 13 and 21 have not substantively changed, and Applicants reiterate their arguments made in their opening Appeal Brief with respect to both claims.

For at least the reasons set forth above, claims 1, 5, 13, and 21, and all claims depending therefrom, are allowable over the cited references.

Conclusion

For at least the reasons set forth herein, Appellants respectfully request that the Board reverse the rejection of the claims and that the claims be allowed in their current form.

Dated: June 27, 2008   Respectfully submitted,

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